REMARKS/ARGUMENTS

Support for the New Claims

Applicants have added new dependent claims 18-23, and 25-26, and new independent claim 24. Support for the new claims is found at least in the original claims, and in the specification, for example, at least at page 6, lines 6-7 and 21-22 for claim 18; at page 6, lines 16-17 for claim 19; at page 6, lines 11-44 for claim 20; at page 57, lines 26-27 for claim 21 at least in Figure 1 and at page 10, lines 21-24 for claim 24; at page 3, lines 1-2, in Fig. 1, and in original claim 9, for claims 22 and 25; and at page 3, lines 2-3 and in Fig. 1 for claims 23 and 26.

Death of an Inventor

Applicants wish to bring to the attention of the Examiner the death of John Shigeura, an inventor on this application. It is not believed that any documents are required to be filed concerning this matter. If, however, Applicants are incorrect in this assumption, they request notification to that extent and appropriate documents will be submitted.

Telephone Conference

Applicants wish to thank Examiner Barton for the courtesy of a telephone interview on April 29, 2005.

Rejection of the Claims

The Examiner rejected claims 14-17 under 35 U.S.C. 102(e) as allegedly being anticipated by U.S. Patent No. 6,207,031 to Adourian et al. (hereinafter the '031 patent). Applicants respectfully traverse this rejection.

Among other things, the Examiner alleges that the '031 patent teaches "loading wells of a capillary electrophoresis chip (Column 11, lines 4-7), wherein the wells include ***a capillary positioned therein*** (e.g., Figure 8A, capillary at the bottom of the well); and injecting the samples from the wells into the capillaries. (Column 22, lines 26-50). (Emphasis added). Applicants disagree.

It appears that the Examiner is relying on the filing date of U.S. Provisional Application, No. 60/058,798 (hereinafter the '798 application) filed on September 15, 1997 in an attempt to use the '031 patent as prior art. In order to successfully rely on the '798 application, the Examiner must establish that the portion of '031 patent being cited against the Applicants was fully supported in the '798 application. This is not the case.

Applicants draw the Examiner's attention to the fact that Figure 8A in the '031 patent does not appear in the '098 priority application. Rather, the first appearance of Figure 8A is in the '031 patent. The application that ultimately matured into the '031 patent was not filed before the priority date of the Applicants' application. Therefore, reliance upon Figure 8A in the '031 patent cannot support the rejection.

Because Fig. 8A of the '031 patent does not constitute prior art, reconsideration and withdrawal of the rejection are respectfully requested. Similarly, claims 15-17 are patentable at least for the reasons set forth above in connection with claim 14, from which they depend.

Based on all of the above, the rejection of claims 14-17 under 35 USC §102(e) is overcome and should be withdrawn.

The Examiner also rejected claims 14-17 under 35 U.S.C. § 103(a) over Kambara et al (US Patent No. 5,968,331 – hereinafter "the '331 patent") in view of Lauer et al. (US Patent No. 5,207,886 – hereinafter "the 886 patent.") Applicants respectfully traverse this rejection.

The Examiner specifically alleges that the '331 patent teaches "loading wells of a capillary electrophoresis chip (Figure 8, wells 23; Column 9, lines 24-29), wherein the wells include a capillary positioned therein (e.g., Figure 9, capillary at the bottom of the well); and injecting the samples from the wells into the capillaries. (Column 9, lines 24-29)." Applicants disagree.

Figure 9 fails to illustrate that "each loading well includes a capillary ***positioned therein.*** Rather, at column 9, lines 34-50 the '331 patent refers to a "gel cartridge **40**" that is "placed between open capillary cartridge **43** and the separation gel." Furthermore, the invention of claim 14 recites a "method" comprising providing, simultaneously transferring, and injecting samples. In pointing to Figure 9, the Examiner highlights features of the device but the figure does not disclose or suggest the Applicants' claimed "***method***."

The Examiner has acknowledged at page 5, that "Kambara et al do not explicitly disclose temperature control of the work surface." The '886 patent is then cited against the present application in an attempt to remedy this deficiency. Specifically, the Examiner points to Figure 1 and column 5, lines 21-37 of the '886 patent. At line 21, the '886 patent states that "the temperature inside the environment enclosure **11** can be controlled." Neither Figure 1 nor the

cited portion of the '886 patent, however, provides for "simultaneously transferring at least two samples from their respective work surface" wherein ***"the work surface is controlled by a temperature controller."*** Rather, as noted in column 3, beginning at line 26, the apparatus shown in the'886 patent includes "an environmental enclosure **11**, which has access openings. . . for elements that must be connected to elements outside the enclosure." Inside the enclosure **11** is a capillary electrophoresis apparatus but not a plurality of samples located on a temperature-controlled work surface from which the samples can be transferred.

The Examiner also alleges that it would be obvious to modify the method of the '331 patent. Merely because it may be obvious to modify the '331 patent, this is not the same as providing a reasonable motivation or suggestion to combine the '331 patent with the '886 patent. Even assuming, *arguendo,* that the '331 patent could properly be combined with the '886 patent, this would still fail to render the claimed invention obvious for the reasons already elaborated in this reply, in particular, for example, because the '886 patent fails to disclose or suggest a work surface as presently claimed that is controlled by a temperature controller. Therefore, the rejection of claim 14 is overcome. For at least the same reasons, the rejection of claims 15-17 is also overcome. Therefore, the rejection of all the claims under §103(a) must be withdrawn.

The Examiner also rejected claims 14-17 under 35 U.S.C. §103(a) over Briggs et al (US Patent No. 5,560,811 – hereinafter "the '811 patent") in view of Lauer et al. (US Patent No. 5,207,886 – hereinafter "the '886 patent"). Applicants respectfully traverse this rejection.

The Examiner alleges that Briggs et al disclose "simultaneously transferring at least two samples from their respective work-surface coordinates to their respective loading wells, (Figure

4A, Column 5, lines 8-14), wherein the wells include a capillary positioned therein (Figures 1, 2, and 4C); and injecting the samples from the wells into the capillaries. (Column 8, lines 9-24)."

For the same reasons as above, the '886 patent fails to suggest a work surface that "is controlled by a temperature controller." Therefore, the '886 patent, in combination with the '811 patent, fails to remedy any deficiencies in the '811 patent and the rejection of the claims under 35 USC § 103(a) is overcome and should be withdrawn.

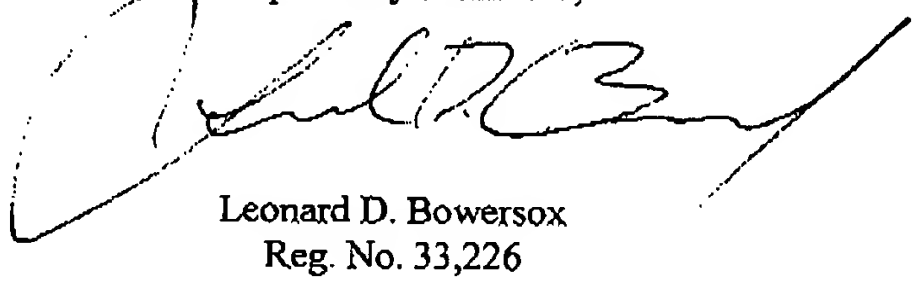
CONCLUSION

In view of the foregoing remarks, Applicants respectfully request favorable reconsideration of the present application and a timely allowance of the pending claims.

Should the Examiner deem that any further action by Applicants or Applicants' undersigned representative is desirable and/or necessary, the Examiner is invited to telephone the undersigned at the number set forth below.

If there are any fee(s) due in connection with the filing of this response, please charge the fee(s) to Deposit Account No. 50-0925. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such extension is requested and should also be charged to said Deposit Account.

Respectfully submitted,



Leonard D. Bowersox
Reg. No. 33,226

KILYK & BOWERSOX, P.L.L.C.
3603-E Chain Bridge Road
Fairfax, Virginia 22030
Tel.: (703) 385-9688
Fax.: (703) 385-9719